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Status of Claims:

Claims 10-20 and 22-26 were rejected. None of the claims are being amended herein.

§102 Rejections

Claims 10-11, 14-16, and 22-26 were rejected under 35 U.S.C. §102(e) as being anticipated by Zirps et al. (U.S. 2004/0220449). Under MPEP 2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the claim, and the elements must be arranged as required by the claim. Under this standard, Applicant submits that Zirps et al. fails to anticipate any of the amended independent claims.

Independent claim 10 recites that “the actuator is adapted to be operated by the same hand holding the handle while the thumb and index finger of the same hand are free to grip and advance the flexible member.” Zirps et al. fails to teach or suggest such limitations, particularly in the arrangement required by independent claim 10. Applicant acknowledges that Zirps et al. need not explicitly teach the recited acts following the “adapted to” phrase in claim 10. However, Applicant notes, and the Office has appeared to acknowledge, that the device taught by Zirps et al. must be capable of performing such recited acts in order to anticipate claim 10 (otherwise, the Zirps et al. device would not be structurally “adapted to” perform the acts as recited in the claim). Applicant submits that the device taught by Zirps et al. is not capable of performing such recited acts or uses. For instance, Zirps et al. teaches that its device’s actuator is to be operated by the user’s thumb (see, e.g., paragraph [0037] and Figs. 1A-1B of Zirps et al.). This is structurally inconsistent with the claim language requiring the thumb and index finger to be free to grip and advance the flexible member while the actuator is operated by the same hand holding the handle. In view of the foregoing, Applicant respectfully submits that Zirps et al. fails to anticipate independent claim 10 in accordance with MPEP 2131, and respectfully requests that the rejection be withdrawn.

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Independent claim 16 recites "an actuator associated with the housing and operable by the hand holding the housing to actuate the end effector; wherein at least the thumb and index finger of the same hand holding the housing are free to grip and release the flexible shaft of the device." Zirps et al. fails to teach or suggest such limitations, particularly in the arrangement required by independent claim 16, for reasons similar to those discussed above with respect to claim 10. Accordingly, Applicant respectfully submits that Zirps et al. fails to anticipate independent claim 16 in accordance with MPEP 2131, and respectfully requests that the rejection be withdrawn.

Independent claim 22 recites that "the actuator is adapted to be operated by the same hand holding the handle and without use of the thumb or index finger of the same hand; and wherein the handle comprises a release operable by the thumb or index finger of the same hand holding the handle." Zirps et al. fails to teach or suggest such limitations, particularly in the arrangement required by independent claim 22, for reasons similar to those discussed above with respect to claim 10. Accordingly, Applicant respectfully submits that Zirps et al. fails to anticipate independent claim 22 in accordance with MPEP 2131, and respectfully requests that the rejections be withdrawn.

§103 Rejections

Claims 12-13 were rejected under 35 U.S.C. §103(a) as being unpatentable over Zirps et al. in view of Ganz et al. (U.S. 5,624,379). Claims 17-20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Zirps et al. in view of Dhindsa et al. (U.S. 6,786,865). Under MPEP 2143, in order to establish a *prima facie* case of obviousness, the prior art reference or combination of references must teach or suggest all of the limitations of a claim. A *prima facie* case of obviousness also requires that there be some teaching suggestion, or motivation to modify the references either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP 2143.01. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

Applicant notes that claims 12-13 depend from independent claim 10. As discussed above, Zirps et al. fails to teach or suggest all of the limitations of claim 10. Applicant further submits that Ganz et al. fails to make up for such deficiencies of Zirps et al. The combined art

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of record therefore fails to render any of claims 10-15 obvious in accordance with MPEP 2143.03. Applicant therefore respectfully requests that the rejections be withdrawn.

Similarly, Applicant notes that claims 17-20 depend from independent claim 16. As discussed above, Zirps et al. fails to teach or suggest all of the limitations of claim 16. Applicant further submits that Dhindsa et al. fails to make up for such deficiencies of Zirps et al. The combined art of record therefore fails to render any of claims 16-20 obvious in accordance with MPEP 2143.03. Applicant therefore respectfully requests that the rejections be withdrawn.

Applicant further submits that claims 22-26 are not obvious for reasons similar to those provided above with respect to claims 10-20.

Furthermore, even if the combined art of record taught or suggested all of the elements of any of the independent claims, the art is devoid of any suggestion or motivation to modify or combine the teachings of the references in order to obtain the claimed invention. Indeed, MPEP 2143.01 admonishes that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." (emphasis in original). *Actual evidence* of a suggestion, teaching, or motivation to combine prior art references must be shown. *In re Dembiczack*, 50 USPQ2d 1614 (Fed. Cir. 1999). Because the evidence of motivation required by MPEP 2143.01 is lacking, Applicant respectfully requests that the rejection be withdrawn.

Beyond the foregoing shortcomings with respect to the rejections of the independent claims, Applicant further notes that the dependent claims include additional limitations not taught or suggested in the art of record, thus forming independent basis for novelty and non-obviousness.

To the extent that the present amendments constitute a narrowing of the claims, such narrowing of the claims should not be construed as an admission as to the merits of the prior rejections. Indeed, Applicant traverses the rejections and preserves all rights and arguments. While Applicant has noted several distinctions over the art of record, Applicant notes that several other distinctions exist, and Applicant preserves all rights and arguments with respect to such distinctions.

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Conclusion

Based on the foregoing, all pending claims are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and an early notice of allowance.

Respectfully submitted,

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